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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,455	02/26/2004	Kevin Morrison	020375-043010	5172
20350	7590	10/11/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			LABAZE, EDWYN	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/789,455

Applicant(s)

MORRISON ET AL.

Examiner

EDWYN LABAZE

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12-18,20-22 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,12-18,20-22 and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged appeal brief filed on 6/27/2006.
2. Claims 1, 3-10, 12-18, 20-22, and 24-27 are presented for examination.
3. After carefully reviewing the previous Office Action and the appellant's arguments, the examiner now applies a broader interpretation of the claims 1, 3-10, 12-18, 20-22, and 24-27 taking into consideration Goldstein (US 2004/0069845) in view of Simpson (U.S. 6,453,300) teaches claimed subject matter. The examiner regrets any inconvenience to the applicant. Accordingly, **the PROSECUTION IS HEREBY REOPENED**. A new ground of rejection is set forth below.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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6. Claims 1, 3-5, 7-10, 13, 15-18, 20-22, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein (US 2004/0069845) in view of Simpson (U.S. 6,453,300).

Re claims 1, 10, 13, and 21: Goldstein et al. teaches transaction card fabrication control system and method, which includes which includes receiving at a host computer system a request from a purchaser to order a presentation instruments, wherein a presentation instrument comprises a physical device {herein Goldstein teaches a system wherein a customer may wish to purchase a bundle of gift cards} used to settle a financial transaction (page 2, paragraphs 009+); receiving at the host computer system the purchase information from the purchaser, wherein the purchase information comprises a recipient information file {herein name of the customer to be printed on the card} and wherein the purchase information comprises an order for a plurality of presentation instruments that comprise gift cards, at least some of which have different values associated therewith {herein Goldstein teaches that a customer may order three different gift cards in \$ 10, \$50, and \$100 denominations from the same manufacturer} (page 5, paragraph 0057); and delivering {herein interpreted as shipping} the presentation instruments in accordance with the purchase information (page 3, paragraphs 0045-0048; page 5, paragraph 0057; page 6, paragraphs 0060+). Goldstein et al. further teaches a computer device {herein computer/controller 1, as shown in fig. # 1} (page 4, paragraphs 0049+). Goldstein further teaches means of personalizing the cards (paragraphs 45+, 78+).

Goldstein fails to specifically teach sending one or more files that are executable by a computer of the purchaser to produce one or more corresponding display screens programmed to collect purchase information relating to the plurality of presentation instruments.

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Simpson teaches personalized greeting card with electronic storage media and method of personalizing same, which includes sending one or more files {herein Simpson teaches means of displaying Flash files prompting the user to select different personalized setups} that are executable by a computer of the purchaser to produce one or more corresponding display screens programmed to collect purchase information relating to the plurality of presentation instruments (see figs. # 5-9; col.6, lines 1-67; col.12, lines 3-65).

In view of Simpson's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Goldstein means of displaying application files requesting information for completing the online gift cards purchase. Furthermore, such modification would enable the use to customize the gift card, accessing registry database, providing personal information {such means of payment, delivery address, shipping time and the like} for completing the transaction. Moreover, such modification would have been an obvious extension as taught by Goldstein.

Re claim 3: Goldstein et al. as modified by Simpson discloses a system and method, wherein delivering the presentation instruments in accordance with the purchase information comprises delivering {herein interpreted as shipping} the presentation instruments to each of a plurality of recipients (page 5, paragraph 0057; page 6, paragraph 0060).

Re claim 4: Goldstein et al. teaches a system and method, wherein delivering/shipping the presentation instruments in accordance with the purchase information comprises delivering the presentation instruments to the purchaser (page 5, paragraphs 0057+).

Re claim 5: Goldstein et al as modified by Simpson discloses a system and method, wherein delivering the presentation instruments in accordance with the purchase information

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comprises delivering the presentation instruments to a designee of the purchaser (page 7, paragraph 0065+).

Re claims 7, 18, and 25: Goldstein et al. as modified by Simpson discloses a system and method, wherein the recipient information file comprises a selection from the consisting of a spreadsheet, a text file, and a data file (page 9-10, paragraphs 0078-0079).

Re claims 8, 15, and 26: Goldstein et al. as modified by Simpson teaches a system and method, wherein the purchase information comprises a message to be embossed on each card (page 9-10, paragraphs 0078-0079).

Re claims 9, 16-17, and 27: Goldstein et al. as modified by Simpson discloses a system and method, purchase information comprises a recipient name to be embossed on each card (page 6, paragraph 0059).

Re claim 20: Goldstein et al. as modified by Simpson teaches a system and method, wherein the presentation instruments comprise non-personalized {herein Goldstein et al. discloses that the card production can be made at any suitable point in manufacturing, such as from the first processing steps or any point thereafter. For example, production of each card in a group may be tracked from initial assembly of printed sheets or other card parts, or after cards in the group are personalized} cards (page 3, paragraph 0045+).

7. Claims 6, 12, 14, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein et al. (US 2004/0069845) as modified by Simpson (6,453,300) above in claim 1, and further in view of Phillips et al. (US 2004/0064412).

The teachings of Goldstein et al. as modified by Simpson have been discussed above.

Goldstein et al. as modified by Simpson fails to teach means a request from a user to view usage information relating the card.

Phillips et al. discloses debit purchasing of stored value card for use by and/or delivery to others, which includes means a request from a user to view usage information relating the card (paragraphs 35+)

In view of Phillips et al.'s teachings, it would have been obvious to an artisan of ordinary skill in the art at the invention was made to employ into the teachings of Goldstein et al. as modified by Simpson a request from a user to view usage information relating the card so as to control/view the usage/amount of the stored value on the card. Furthermore, such modification would enable the customer to keep track of the remaining balance, usage of the card {such as when, where, how the card has been used} in order to prevent fraudulent activities.

Another advantage of viewing the usage of the card is to replenish the amount if necessary, such method is also employed in the credit/debit card application {wherein some parents would purchase or prepaid a card for their college kids and monitor the usage and/or transactions so as to replenish/add money/funds onto the card into to permit the continuing use of the card}, wherein the customer/purchaser can track/monitor the usage of the card. Moreover, such modification would have been an obvious extension as taught by Goldstein et al. as modified by Simpson, therefore an obvious expedient.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cowell et al. (US 2003/0177067) discloses systems and methods for ordering and distributing incentives messages.

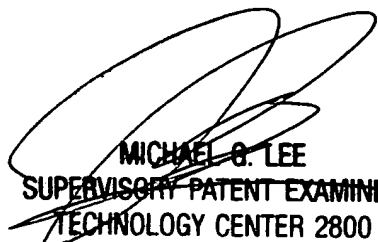
Martinez (US 2005/0263587) teaches system and method for initializing presentation instruments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

el
Edwyn Labaze
Patent Examiner
Art Unit 2876
October 2, 2006


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